

Applicant Docket No. 19011.1140

REMARKS

This paper is responsive to the Office Action mailed December 20, 2004. The Office has rejected each of the pending 13 claims. The applicant submits the foregoing amendments along with these remarks in support of allowing the presently submitted claims.

Claim Rejections – 35 USC § 112

The Office has rejected claims 1-3, 9 and 13 under 35 U.S.C Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

First of all the applicant wishes to point out that this is the third substantive Office Action for this case and as such, the applicant is curious as to why a claim rejection based on 35 USC Section 112 is just now being raised.

Use of the term “narrowly”

More specifically, the Office has pointed towards the word “narrowly” appearing in claims 1-3 and 13 stating that this language fails to distinctly claim the applicant’s invention because the scope of the claim is unclear. Moreover the specification fails to clarify the meaning of the limitation.

The Office’s attention is drawn to the fact that the term “narrowly” has been present in these claims as originally filed. However, the Office has failed to raise this rejection and has failed to find any issues with the use of the term “narrowly” in both the June 6, 2003 and the March 30, 2004 Office Actions.

Furthermore, the applicant conducted a simple search of issued United States Patents and discovered that the term “narrowly” is used in the claims of 505 issued patents and the term “narrow” is used in the claims of 38,514 issued patents. Thus, it is the applicant’s conclusion that the Office, in general, does not object to the use of this word in a claim.

With regards to the applicant’s specific use of the term, the applicant would like to point out that the specification does indeed offer a definition for the term “narrowly selected” which is how the term “narrow” is used in the claims. Claims 1 and 13 recite “narrowly making a

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selection". Claims 2-3 further define this step reciting "the step of narrowly selecting". On page 3 of the specification, lines 1-5, the applicants define the term "narrowly selected" using the following language:

It is significant, however, that the selection of prospects is performed on a narrowly selected basis. As defined herein, "narrowly selected" means that the agent 14 is not selecting an entire mailing list of thousands or even hundreds of names, but is selecting either an individual prospect or a very small number of prospects, defined herein to be less than 100 at a time.

The applicant apologizes if we do not offer the correct page and line numbers, the present firm inherited this case from the original firm and from the best of our records, we believe we have the correct pagination and line numbers. However, from the above cited passage, it is clear that this term is well supported and well defined and that the scope of the claim is clear. The applicant respectfully requests the Office to withdraw its rejection of claim 1, as well as claims 2-3 and claim 13.

Use of the term "substantially"

The Office has rejected claim 9 under 35 U.S.C. Section 112 focusing on the word substantially. The Office alleges that this language fails to distinctly claim the applicant's invention because the scope of the claim is unclear. In addition, the Office alleges that the specification fails to clarify the meaning of the limitation.

Again, the applicants wish to point out that the term "substantially" was present in claim 9 as originally filed and that the Office raising this issue at this point in the prosecution of the case is substantially irritating. The Office has had plenty of opportunity to raise this rejection in the first two Office Actions. The applicants can only conclude that the Office has not been properly examining this case.

Furthermore, the applicant conducted a simple search of issued United States Patents and discovered that the term "substantially" is used in the claims of 806,797 issued patents. Thus, it is the applicant's conclusion that the Office, in general, does not object to the use of this word in a claim.

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With regards to the applicant's specific use of the term, the applicant would like to point out that the specification does indeed offer a definition for the term "substantially synchronous link" which is how the term "substantial" is used in claim 9. The specification defines this term as follows:

The commercials may also advantageously include a hyperlink to a web site, and initiate a substantially synchronous link such as a telephone call or chat room exchange between the prospect and the advertiser. Page 1, lines 11-13.

and

One particularly advantageous method of responding involves the prospect engaging an icon, button, or other trigger that sends a message back to either the originating agent or some other agent. The message may, for example, ask that the agent call the prospect on the telephone, or send additional information. A system that provides such phone response tracking is Instantcall™. As another example, the message may open a chat room type dialog between prospect and agent, such as that provided by Eyecontact™. Such responses are highly desirable because they initiate a substantially synchronous link between the prospect and the agent. Page 6 lines 8-15.

Again, the applicant apologizes if we do not offer the correct page and line numbers but these passages should be relatively easy to locate in the specification as the references are not exact. However, from the above cited passage, it is clear that this term is well supported and well defined and that the scope of the claim is clear. The applicant respectfully requests the Office to withdraw its rejection of claim 9.

Claim Rejections – 35 USC § 103

The Office has rejected claims 1-13 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent application number 2001/0003099 A1 in the name of *Von Kohorn* in view of U.S. Patent Number 5,966,380 to *Przygienda*.

First of all, the applicant's heart goes out to the examiner that ends up having to examine the 333 claim 705 paragraph *Von Kohorn* reference. However, as pointed out the Office, *Von*

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Kohorn vials to described, suggest or teach the elements of:

a third party electronically communicating the selected commercial to the selected prospect;

the selected prospect making a response to the selected commercial;

the third party tracking the response made by the selected prospect; and

the third party reporting back to the advertiser with information relating to the response to the selected commercial.

The applicant would like to further point out that Von Kohorn also fails to disclose an advertiser narrowly making a selection of a prospect and a commercial and identifying this selection to a third party.

The Office alleges that Von Kohorns definition of "host", which is defined as:

an on-stage and an off-stage announcer, master of ceremonies, program director, guest host and celebrities, announcers of commercials and any other individual associated with the program or appointed to carry out one or more of the activities enumerated herein. It also is intended to include the individuals engaged in the operation of formulating a message or program for broadcasting on behalf of an advertiser, manufacturer, store or sponsor. Paragraph 115

In conjunction with the following passage discloses this element of claim 1.

A great advantage of the invention is that the use of the network program material interspersed among local programming material allows people across the country to participate simultaneously in a common contest, or a common learning experience, or in a common national survey, by way of example. The use of alternative network programs inserted in opportune time slots allows the central stations to insert the network programs within the regular broadcasting schedules of the respective central station in a manner similar to that of the usual interruption of a broadcast program for a message from an advertiser or sponsor. Thereby, the invention allows for the simultaneous participation of people from across the country to be accomplished without need for any significant rescheduling of local programming.

It is clear that this does not meet the requirements of an advertiser narrowly making a

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selection of a prospect and a commercial. There is not even a hint of this element being performed in the cited reference. If the Office disagrees with the applicant, the Office is requested to provide specific references within the cited application that show an advertiser is narrowly selecting a prospect and a commercial and then communication this selection to a third party.

Further, the Office alleges that *Przygianda* discloses the steps of:
identifying the selection to a third party
the third party electronically communication the selected commercial to the selected prospect

the selected prospect making a response to the selected commercial
the third party tracking the response made by the selected prospect and
the third party reporting back to the advertiser.

Once again, the applicant is very disappointed in the references that are cited against these pending claims. The cited art is totally irrelevant. *Przygianda* simply describes a network structure. The first portion of the Office cited reference tells the entire story:

The present invention pertains to a communication network 12. The communication network 12 comprises a first node 14a. The first node 14a comprises a mechanism 16 for communicating with a second node 14b to which it is connected. The first node 14a also comprises a mechanism 18 for maintaining information about itself, the second node 14b and a third node 14c. The maintaining mechanism 18 is connected to the communicating mechanism. Also, the first node 14a comprises a mechanism 20 for comparing new information received from the second node 14b to old information previously received from the second node 14b and updating the old information with new information by incrementing the old information with the new information.

The applicant begs the Office to show how a multi-node network in which a first node has a mechanism for communicating with a second to which it is connected, and also having a mechanism to maintaining information about itself, the second node and the third node in anyway whatsoever is related to:

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- (a) identifying a selected prospect and commercial to a third party
- (b) electronically communicating the commercial to the selected prospect
- (c) the selected prospect making a response to the selected commercial and
- (d) the third party communicating the response back to the advertiser.

Even if for argument purposes you say the advertiser is the first node, the third party is the second node and the selected prospect is the third node, which is a completely illogical analogy, the cited reference still does not come close to describing these elements of the invention. Where does the first node identify a selected prospect and commercial to a third party? The first node only provides information to the second node pertaining to the first node – the advertiser. This information could not possibly be read to include information about a prospect and a commercial. Where does the reference show that the third node makes a response to the information communicated by the second node, much less a response to a commercial?

Moreover, the Office is required to show why it would be obvious to combine these references. The applicants fail to find any motivation for combining a communications network structure patent with an application focused on providing solicitations embedded in wide area broadcast programming. Much more, combining these references does not describe, suggest or teach each element of the claimed invention.

The arguments presented here with regards to claim 1, equally apply to claim 13. The applicant submits that claim 1 and 13 are allowable over the cited references and request the Office to kindly move them towards allowance. The remaining claims depend either directly or indirectly from either claim 1 or claim 13 and thus are also allowable.

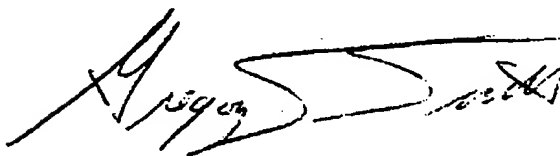
CONCLUSION

Applicant respectfully submits the claims are allowable over the cited references and further, that the combination of the references do not disclose each and every element of the claims and finally, that it was improper for the Office to combine these two references. Thus, the applicant respectfully request the Patent Office to move this case towards allowance. The applicant invites the Patent Office to contact the undersigned at its convenience should the Patent Office believe it

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would facilitate prosecution of this application. Applicant thanks the Examiner for consideration of this application.

Respectfully submitted,



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